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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,296	05/30/2001	Tatsushi Nashida	450100-03302	7330
20999 7590 05/03/2007 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER HOSSAIN, FARZANA E	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 05/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/870,296

Applicant(s)

NASHIDA ET AL.

Examiner

Farzana E. Hossain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/15/2007 has been entered.

Response to Amendment

2. This office action is in response to communications filed 09/27/2006. Claims 1-6 are pending. Claims 1 and 4 are amended. Claim 2 is previously presented. Claims 3, 5, 6 are original. Claim 7 is cancelled.

Response to Arguments

3. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

The applicant argues that Kuroda disclose a device recorder for recording and playing data streams of audio, video and related information as well as a device for displaying an EPG and Zigmond relates to displaying advertisements and that the combination lacks motivation (Pages 7-8). The applicant argues that improper hindsight using Applicants' claimed invention as a blueprint (Page 8).

In response to applicant's argument, Zigmond discloses recording programs and inserting advertisements into recorded programs based on user attributes (Column 7, lines 9-12, Column 11, lines 31-65). Zigmond discloses user information management means for storing user information about each requesting origin (Figure 5, 82), and obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means to the external device and inserting the information in a recorded program or the household device or advertisement insertion device has a connection means to external devices including video tape or any other medium carrying recorded video programming which has the stored video program and advertisements appropriate for a user attribute is inserted into the recorded program (Figure 5, Figure 6). The motivation for combination provided in the last office action is for the benefit of receiving payment from advertiser (Column 1, lines 23-35).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

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not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The applicant also argues that Kuroda in view of Zigmond and Ellis do not disclose the new limitation "the storage means permanently stores self-diagnostic data relating to content recording and reproducing sequences corresponding to expansion and compression of the original recorded program" (Pages 6-8).

The examiner argues that there is no support for the limitation. See 112 rejection below. Also, the examiner argues that storage means permanently stores means permanent storage and permanent storage is the type of computer storage that keeps the data or its contents regardless if the power is turned off or the if the storage device is moved to another computer. See new rejection below.

4. Applicant's failure to adequately traverse the Examiner's taking of Official Notice for Claim 3 in the previous office actions is taken as an admission of the facts noticed.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention; and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 1 ^{and 4} ~~and 4~~ rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 4 recite, "the storage means permanently stores self-diagnostic data relating to content recording and reproducing sequences corresponding to expansion and compression of the original recorded program."

The applicants' specification discloses that the ROM permanently stores control codes for self-diagnostic programs executed during a power on sequence for the content recording and reproducing system (Page 13, 4th paragraph). There is no support that self-diagnostic data is stored in the same storage means as the recording program and that it relates to the compression and expansion of the original recorded program.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (US 6,311,011) in view of Zigmond et al (US 6,698,020 and hereafter referred to as "Zigmond") and Chung et al (US 2006/0204225 and hereafter referred to as "Chung").

Regarding Claims 1 and 4, Kuroda disclose a recording system for recording and/or reserving a broadcast program (Figure 1) and a recording substitution system for substitutionally recording a broadcast program (Figure 1), comprising: means for accepting a request to record and/or reserve a broadcast program (Column 4, lines 18-50); storage means for recording a broadcasting program (Column 4, lines 18-50, Figure 2, 103, 105); connection means for connecting with an external device (Column 5, lines 60-65); means for receiving a broadcast program (Figure 1, Figure 2) determination means for determination whether it is possible to record a broadcast program requested to recorded and/or reserved (Column 5, lines 60-65); means for issuing a recording substitution request to an external device via the connection means in response to a negative result of the determination (Figure 22, Figure 7). Kuroda discloses recording substitution means or the recorder/player for responding to reception of a recording substitution request via connection means and receiving and recording a corresponding broadcast in the storage means (Column 5, lines 60-65, Figure 7). Kuroda discloses the recording system or recording substitution system receives and records television programs in the storage means or the external device, which inherently comprises commercials. Kuroda is silent on user information management means for storing user information about each requesting origin, and obtaining advertising information

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appropriate for a user attribute of the requesting origin via the connection means and the storage means permanently stores self-diagnostic data relating to content recording and reproducing sequences corresponding to expansion and compression of the original recorded program.

Zigmond discloses user information management means for storing user information about each requesting origin (Figure 5, 82), and obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means to the external device and inserting the information in a recorded program or the household device or advertisement insertion device has a connection means to external devices including video tape or any other medium carrying recorded video programming which has the stored video program and advertisements appropriate for a user attribute is inserted into the recorded program (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65). Chung discloses the storage means permanently stores self-diagnostic data relating to content recording and reproducing sequences corresponding to expansion and compression of the original recorded program (Pages 4-6, paragraph 0066-0075, 0078, Figures 3A-D, Figure 5, Figures 7-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuroda to include that the user information management means for storing user information about each requesting origin (Figure 5, 82), and obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means to the external device and inserting the information in a recorded program or the household device or advertisement insertion

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device has a connection means to external devices including video tape or any other medium carrying recorded video programming which has the stored video program and advertisements appropriate for a user attribute is inserted into the recorded program (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65) as taught by Zigmond in order to provide advertisements that are more interesting to the viewer for premium payment from the advertiser (Column 1, lines 23-35) as disclosed by Zigmond. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuroda to include the storage means permanently stores self-diagnostic data relating to content recording and reproducing sequences corresponding to expansion and compression of the original recorded program (Pages 4-6, paragraph 0066-0075, 0078, Figures 3A-D, Figure 5, Figures 7-10) as taught by Chung in order to prevent screen interruption during playback (Page 1, paragraphs 003, 007-0010) as disclosed by Chung.

Regarding Claim 2, Kuroda, Zigmond and Chung disclose all the limitations of Claim 1. Kuroda discloses the determination means generates a negative result when a remaining capacity of the storage means is not sufficient for recording a broadcast program requested to be recorded and/or reserved (Figure 7, Column 5, lines 60-65).

Regarding Claim 5, Kuroda, Zigmond and Chung disclose all the limitations of Claim 4. Kuroda discloses when the recorder is connected with the Internet; the video recorder may store signals via World Wide Web in the temporary storage device (Column 12, lines 28-44). It is noted that the World Wide Web records data from a

plurality of external devices (plurality of users) and the substitution means is located upstream from the user and records program per users requests.

Regarding Claim 6, Kuroda, Zigmond and Chung disclose all the limitations of Claim 4. Kuroda discloses comprising user information management means for storing user information about each requesting origin, wherein the recording substitution means records a broadcast program in a format appropriate for a user attribute of the requesting origin including HDD format, DVD format or VCR format (Figure 1, 105, Figure 7, Figure 22).

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda in view of Zigmond and Chung as applied to claim 1 above, and further in view of an applicant's admission of fact.

Regarding Claim 3, Kuroda, Zigmond and Chung disclose all the limitations of Claim 1. Kuroda, Zigmond and Chung are silent on the determination means generates a negative result when a failure in the system prevents a broadcast program from being recorded in the storage means. Applicant's admission of fact provides evidence to include redundant storage devices in the situation wherein a given storage device is not working or failing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Kuroda, Zigmond, and Chung to include the claimed limitation for the benefit of ensuring a program is recorded in situations of a recorder failing or not working.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farzana E. Hossain whose telephone number is 571-272-5943. The examiner can normally be reached on Monday to Friday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FEH
April 25, 2007


SCOTT E. BELIVEAU
PRIMARY PATENT EXAMINER